REMARKS

Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 5, 9, 13, 15-19, and 22 have been amended, and new claims 23-31 have been added. Support for any new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC Section 102(b)

Claims 1-16 have been rejected under 35 USC Section 102(b), as being anticipated by U.S. patent 5,802,420 to Garr et al. ("Garr"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 1, 5, 9, 13, 15, and 16 and features in the other claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under 102(b), "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385.* The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901,*

185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).* The elements must be arranged as required by the claim. *In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).*

Independent claim 1 (amended), and its dependent claims 2-4, are patentably distinguishable over the cited reference because claim 1 emphasizes the novel features of the present invention in which a third device obtains from a second device operational metrics information about a first device without the third device communicating with the first device. In this regard, claim 1 recites:

"1. (Currently amended) In a distributed computing environment, a method for distributing peripheral device operational metrics information, the method comprising:

receiving, by a first device, a command to perform an imaging operation;

responsive to receiving the command, performing, by the first device, the imaging operation; and

responsive to performing the imaging operation, communicating, by the first device, metrics information corresponding to the imaging operation to a second device;

receiving, at the second device, a request from a third device to access the metrics information; and

responsive to receiving the request, providing access to the metrics information to the third device without the third device communicating with the first device." (emphasis added)

The Garr reference discloses a system in which metrics information associated with a first device, such as the quantity of toner remaining in a toner cartridge of a printer or a corresponding number of remaining pages, can be displayed on a screen of a second device connected to the first device, such as a host computer that is connected to the printer directly or through a network (Abstract; Fig. 7).

Significantly, the Garr reference says nothing about the second device receiving a request from a third device to access the metrics information, or providing access to the metrics information to the third device without the third device communicating with the first device. In

the Garr reference, any device accessing the metrics information must communicate with the first device. If a third device were present in the Garr system and desirous of accessing the metrics information, the Garr reference teaches that the third device would have to communicate with the first device. There is no disclosure in the Garr reference that the third device could obtain access to the metrics information by requesting it from the second device instead of the first device. This feature of the present invention advantageously avoids using valuable resources of the first device, such as bandwidth and processing power, to respond to metrics information requests, and allows the first device's metrics requests to be accessed at any time, even during peak hours of usage of the first device, without causing inconvenient and possibly expensive congestion problems at the imaging device.

The novel features of the present invention are not anticipated by the Garr reference in that the elements of receiving a request from a third device to access the metrics information, and providing access to the metrics information to the third device without the third device communicating with the first device, are absent from the Garr reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 5 (amended), and its dependent claims 6-8, are patentably distinguishable over the cited reference because claim 5 emphasizes the novel features of the present invention in which a third device obtains from a second device operational metrics information about a first device, without the third device communicating with the first device. In this regard, claim 5 recites:

"5. (Currently amended) In a distributed computing environment, a computer-readable medium comprising computer-executable instructions for distributing peripheral device metrics information, the computer-executable instructions comprising instructions for:

receiving, by a first device, a command to perform an imaging operation;

performing, by the first device, the imaging operation; and

responsive to performing the imaging operation, communicating, by the first device, metrics information corresponding to the imaging operation to a second device for access by an application on a third device, such that the application on the third device can access the metrics

information without forwarding any request for the metrics information to the first device." (emphasis added)

For similar reasons as explained above with reference to claim 1, the Garr reference says nothing about a computer-readable medium having instructions with which the first device communicates imaging operation metrics information to the second device for access by an application on the third device, such that the application on the third device can access the metrics information without requesting it from the first device. Therefore, the novel features of the present invention are not anticipated by the Garr reference at least for that reason, and thus the rejection is improper and should be withdrawn.

Independent claim 9 (amended), and its dependent claims 10-12, are patentably distinguishable over the cited reference because claim 9 emphasizes the novel features of the present invention in which a third device obtains from a second device operational metrics information about a first device, without the third device communicating with the first device. In this regard, claim 9 recites:

"9. (Currently amended) An imaging device comprising:
a memory comprising computer-executable instructions for distributing metrics information corresponding to imaging operations;
a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory, the computer-executable instructions comprising instructions for:
receiving, by a first device, a command to perform an imaging operation;
performing, by the first device, the imaging operation; and
responsive to performing the imaging operation, communicating, by the first device, metrics information corresponding to the imaging operation to a second device for access by an application on a third device, such that the application on the third device can access the metrics information without forwarding any request for the metrics information to the first device." (emphasis added)

For similar reasons as explained above with reference to claim 1, the Garr reference says nothing about an imaging device having instructions with which the first device communicates imaging operation metrics information to the second device for access by an application on the

third device, such that the application on the third device can access the metrics information without requesting it from the first device. Therefore, the novel features of the present invention are not anticipated by the Garr reference at least for that reason, and thus the rejection is improper and should be withdrawn.

Independent claim 13 (amended), and its dependent claims 14 and 16, are patentably distinguishable over the cited reference because claim 13 emphasizes the novel features of the present invention in which at least a portion of the imaging metrics are automatically communicated to an order processing utility. In this regard, claim 13 recites:

"13. (Currently amended) In a distributed computing environment, a method for providing real-time imaging metrics information, the method comprising:

receiving, at a server device, imaging metrics corresponding to an imaging operation, the imaging operation having been performed by an imaging device; and

responsive to receiving the imaging metrics, automatically communicating the at least a portion of the imaging metrics to an order processing utility." (emphasis added)

The limitation of "an order processing utility" is one of two limitations in the alternative which were recited in claim 17 prior to its amendment herein. Claim 17 was rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 5,802,420 to Garr et al. ("Garr") in view of U.S. patent application publication 2002/0172520 to Suyehira ("Suyehira"). As discussed hereinafter with regard to claim 17, Suyehira has been eliminated as a reference as provided by 35 USC Section 103(c). The Garr reference does not disclose automatically communicating the imaging metrics to an order processing utility. Therefore, the rejection of claim 13, rewritten herein to include one of the two limitations in the alternative of claim 17, is improper at least for this reason and should be withdrawn.

Dependent claim 15 (amended) has been rewritten to depend from independent claim 17 (amended), and is allowable based on the allowability of claim 17, as is discussed hereinafter.

Rejection Under 35USC Section 103

Claim 17 has been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 5,802,420 to Garr et al. ("Garr") in view of U.S. patent application publication 2002/0172520 to Suyehira ("Suyehira").

Applicant respectfully asserts that the Suyehira reference is not a valid prior art reference. As provided by 35 USC section 103(c) for any application filed on or after the date of enactment, November 29, 1999:

"(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The Examiner will note that the Suyehira reference and the present application are assigned to the same entity. More specifically, the Suyehira reference was filed May 16, 2001, and was originally assigned to the Hewlett-Packard Company, *see* Reel/Frame 012080/0987 recorded August 13, 2001. The Suyehira reference was later assigned to the Hewlett-Packard Development Company, L.P., *see* Reel/Frame 014061/0492 recorded September 30, 2003.

The present application was filed February 26, 2002, and was originally assigned to the Hewlett-Packard Company, *see* Reel/Frame 012870/0636 recorded May 6, 2002. The present application was later assigned to the Hewlett-Packard Development Company, L.P., *see* Reel/Frame 013776/0928 recorded June 18, 2003. Thus, at the time the claimed invention of the present application was made, it was owned by the same entity or subject to an obligation of assignment to the same entity as the Suyehira reference, i.e., the Hewlett-Packard Company.

The Suyehira reference was filed before, but was not published and did not issue until after, the present application's filing date. Therefore, the disclosure of the Suyehira reference is available only as 35 U.S.C. § 102(e)-type prior art. In that regard, 35 U.S.C. § 103(c) now provides that the Suyehira reference "shall not preclude patentability" of the claimed invention.

Therefore, the rejection of claim 17, rewritten herein in independent form and to recite

only one of the two alternative applications, is improper at least for this reason and should be withdrawn.

Claims 18-22 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 5,802,420 to Garr et al. ("Garr") in view of the book Microcomputer Interfacing by Harold S. Stone (1983) and the web page article Polling Mode: Interrupts Versus Polling available at http://www.mathworks.com. Applicant respectfully traverses the rejection and requests reconsideration based on the amendments to claims 18-19 and 22, and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

As to a rejection under 103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)*. The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

Dependent claim 18 (amended) depends from independent claim 13. Applicant respectfully traverses the rejection and requests reconsideration based on the dependence of this

claim on independent claim 13, whose reasons for allowability over the Garr reference have been discussed heretofore and against which the Stone and mathworks.com references have not been cited.

Independent claim 19 (amended), and its dependent claims 20-21, are patentably distinguishable over the cited references because claim 19 emphasizes the novel features of the present invention in which a server device communicates metrics for an imaging device to an application program executing on a device different from the imaging device and the server device. In this regard, claim 19 recites:

"19. (Currently amended) In a distributed computing environment, a computer-readable medium comprising computer-executable instructions for providing real-time imaging metrics information, the computer-executable instructions comprising instructions for:

receiving, at a server device, imaging operational metrics corresponding to an imaging operation, the imaging operation having been performed by an imaging device;

receiving, at the server device, a request from an application program for at least a portion of the imaging operational metrics, the application program executing on another device different from the imaging device and the server device; and

communicating the at least a portion of the imaging operational metrics to the application program." (emphasis added)

For similar reasons as explained above with reference to claim 1, the Garr reference says nothing about a computer-readable medium having instructions with which a server device receives imaging metrics from an imaging device, and then communicates at least a portion of the imaging metrics to an application program executing on another device which is different from both the imaging device and the server device. Nor do the Stone or mathworks.com references on polling and real-time interrupts teach or suggest such limitations. Therefore, the applied references, alone or in combination, do not teach or suggest all of Applicant's claim limitations.

In addition, there is no reasonable expectation of success, in that the Garr reference teaches that the application program (whose user interface is depicted in Fig. 7) executes on the same device that receives the imaging metrics from the imaging device in order to display the

toner remaining and pages remaining. This is unlike the limitation of claim 19 in which the application program executes on a different device than the one that receives the imaging metrics from the imaging device. With such features, a billing utility or an order processing utility can avoid consuming valuable resources of the imaging device, such as bandwidth and processing power, in performing their billing or order processing activities. Therefore, the Garr reference teaches away from the computer-readable medium recited in claim 19.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicant's invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 22 (amended) is patentably distinguishable over the cited references because claim 22 emphasizes the novel features of the present invention in which a server device communicates metrics for an imaging device to an application program executing on a device different from the imaging device and the server device. In this regard, claim 22 recites:

"22. (Currently amended) A server comprising:

a memory comprising computer-executable instructions for providing real-time imaging metrics information;

a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory, the computer-executable instructions comprising instructions for:

receiving, at the server, an unsolicited set of imaging operational metrics corresponding to an imaging operation, the imaging operation having been performed by an imaging device;

receiving, at the server, a request from an application program for at least a portion of the imaging operational metrics, the application program executing on another device different from the imaging device and the server; and

communicating the at least a portion of the imaging operational metrics to the application program." (emphasis added)

For similar reasons as explained above with reference to claim 19, the applied references, alone or in combination, to not teach or suggest the limitations of a server having instructions

with which the server receives imaging metrics from an imaging device, and then communicates at least a portion of the imaging metrics to an application program executing on another device which is different from both the imaging device and the server. In addition, there is no reasonable expectation of success.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicant's invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such

charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,

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